

**REMARKS**

The Examiner, Ms. Verbitsky, is thanked for the courtesy extended applicants' attorney during the interview of March 17, 2004, at which time proposed amendments to the claims were discussed, as presented by this amendment. It is noted that the Examiner indicated that the amendments appear to overcome the rejections of the claims under 35 U.S.C. §112, second paragraph, which are the only rejections set forth and that an Interview Summary will be forwarded.

It is noted in the Office Action, the Examiner has indicated that claim 13 is allowed and that claims 12 and 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. §112, second paragraph, set forth in this Office Action. Applicants submit that by the present amendment, claims 12 and 14 have been amended in a manner which is considered to overcome the rejection under 35 U.S.C. §112, second paragraph, and in a manner corresponding to that of allowed claim 13. Additionally, applicants submit that claims 1 and 2 have been amended in a similar manner, such that these claims and the dependent claims should also be considered to overcome the rejection under 35 U.S.C. §112, second paragraph.

Applicants note that although not discussed with the Examiner at the interview, the Office Action dated December 19, 2003, is indicated as being a "final" Office Action, and applicants traverse the finality as being premature. More particularly, reference is made to MPEP §706.07(a) which provides:

Under present practice, second or any subsequent action on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (emphasis added)

As is apparent, while the Examiner in the prior Office Action of April 10, 2003 objected to the claims and rejected claims under 35 U.S.C. §112, first paragraph and

second paragraph, the objections and rejections were solely directed to "caspidal part of acicular member" while indicating that applicant should clarify in the claims what "caspidal" part is. Applicants responded by changing "caspidal" part to "tip" part while retaining the other language of the claims essentially without amendment. In the Office Action of December 19, 2003, the Examiner rejects the claims under 35 U.S.C. §112, second paragraph, while specifically pointing to indefiniteness and inaccuracies with regard to the claimed language originally presented and not amended by the Amendment of September 9, 2003. Thus, applicants submit that the final rejection of claims 1-12 and 14 under 35 U.S.C. §112, second paragraph, for the reasons set forth by the Examiner, represents a new ground of rejection not necessitated by amendment of the claims as effected by the Amendment of September 9, 2003, it being recognized that the prior rejection of claims under 35 U.S.C. §112, was overcome by the amendments as set forth. Thus, applicants submit that the finality of the rejection is improper and premature and should be withdrawn.

Turning to the rejection of claims 1-12 and 14 under 35 U.S.C. §112, second paragraph, as noted above, claims 1, 2, 12 and 14 have been amended in a manner which is considered to be responsive to the points raised by the Examiner, and at least, claims 12 and 14, as indicated by the Examiner, should now be in condition for allowance.

With respect to claims 1 and 2, applicants note that such claims have also been amended in a manner which is considered to overcome the points noted by the Examiner and now recite the feature of a polarization modulator for modulating a direction of polarization of light from the light source, an optical member for irradiating the tip part of the metal member with light from the polarization modulator so as to generate near field light around the tip part of the metal member, a mechanism or distance controlling for controlling distance between the tip part of the metal member and an object or between the sample and the probe, and a detector

for detecting light in the manner defined. Thus, each of the points raised by the Examiner have been clarified and applicants submit that claims 1 and 2 and the dependent claims thereof should now be considered to be in compliance with 35 U.S.C. §112, second paragraph. It is noted that the Examiner in the Office Action indicated that it is not possible to apply prior art to claims 1-11, but applicants note that the features as now recited in claims 1 and 2 correspond generally to the features as recited in claims 12 and 13 directed to an optical apparatus and applicants submit that the Examiner has recognized that such features are not disclosed or taught in the cited art, such that claims 1 and 2 and the dependent claims 3-11 which recite further features not disclosed in the cited art patentably distinguish over the art of record and should now be in condition for allowance.

For the foregoing reasons, applicants submit that all claims present in this application should be considered to be in compliance with 35 U.S.C. §112, second paragraph, and all claims should now be in condition for allowance. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (501.41069X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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